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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,060	03/02/2000	Andrew Scott Field	KDO.188020-1	5292

25763 7590 12/13/2002

DORSEY & WHITNEY LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
50 SOUTH SIXTH STREET  
MINNEAPOLIS, MN 55402-1498

EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 12/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/518,060

Applicant(s)

FIELD ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant amended page 1 to claim priority to Provisional Patent Application serial number 60/123,328, filed on March 8, 1999. Claim 1 was amended. All pending claims, 1-17, were examined in light of the amendment and stand rejected in this non-final office action.

### ***Response to Arguments***

Applicant's arguments with respect to Claims 1-17 have been considered but are moot in view of the new ground(s) of rejection. Freedman, patent number 4,839,829, was cited as new art to address Claim 1 as amended.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1, 2, 4-6, 9-13, and 15-17 are rejected under 35 USC 103(a) as being unpatentable over Freedman, patent number 4,839,829, in view of Seybold Report (a collection of articles cited in PTO-892 Items: U and V).**

Freedman teaches an automated control system and method for the printing of a work using a variety of conventional and emerging graphic arts processes and techniques. The system interacts with a user or customer, herein referred to as a requester, over a computer network for collecting and storing information or parameters regarding the requester's needs (e.g. cost requirements, photos, pictures, graphics, colors used). The information gathered from the requester is correlated with a database of stored information from a specific or various printing facilities, and the requester is instantaneously provided with accurate information regarding costs, print facility capacity, scheduling, and with information relating to relevant alternatives which can expedite the ordering process (please see at least abstract; Fig. 1a (12, 20, 24, 36, 44); Fig. 2a; col. 1, line 10 through col. 4, line 2). Freedman teaches the network incorporating expert systems software that reviews the inputs from the requester. Once the central computer is provided with all the previously described information for the printing job, the computer automatically returns cost information, timing, and other pertinent information to the requester's computer. Freedman teaches requester batch loading and entire work and transmitting a work comprising: newsletters, magazines, books, pamphlets, poster, reports, flyers, direct mail items, directories, business cards and "virtually all types of printed matter," and delivering printed material to the requester (see at least col. 8, line 14). Freedman further teaches the requester connecting to the printing service remotely from home, office, or from an "in-house" computer located in the same

building or building complex, and the online service collecting requester billing data (see at least col. 8, lines 1-5). Freedman further teaches supplying the service with printing parameter information specifying color printing requirements, and print process that support color printing (see at least).

Freedman teaches all the above as noted under the 103(a) rejection and further teaches supplying to the requester a configurator, and returning an automated cost calculation back to the requester, but does not disclose supplying the cost calculator to the requestor. Seybold Report teaches the current state of printing industry regarding use of the Internet and further teaches A&a Printers establishing an Internet web site using HTML that allows requesters to submit print jobs online and to estimate job costs before committing to the printing service using online estimating tools to calculate shipping-weight and spine-thickness (see at least Item U, pages 2 and 7; Item V, pages 1-5). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Freedman to supply cost calculators as taught by Seybold Report, in order to help requesters conveniently estimate printing costs prior to committing with a printing service provider.

Freedman teaches all the above as noted under the 103(a) rejection and further teaches use of computer networks and telephone lines as a communication medium, but do not specifically disclose a global communication network. Seybold Report teaches all the above as noted under the 103(a) rejection and further teaches use of the Internet to connect requesters with

Art Unit: 3625

printing services. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Freedman to include the Internet as a global communications network as taught by Seybold Report, in order to market services on a global basis, and thereby increase revenue opportunities for the services site.

Freedman teaches all the above as noted under the 103(a) rejection and further teach printing to encompass any and all processes comprising letter press, intaglio, gravure, lithographic, electrophotographic, flexographic, ink jet, thermographic, and offset lithographic (see col. 4, lines 33-35). Freedman, however, does not disclose a digital press. Seybold Report teaches all the above as noted under the 103(a) rejection and further teaches a company offering prepress operations and graphic design agency that uses a variety of modern printing technologies including an Indigo E-Print digital press (see at least Item: U, pages 5 and 6). Therefore it would have been obvious to one of ordinary skill in the art a time of the invention to modify the system and method of Freedman to include a digital press as taught by Seybold Report, in order to sell services offering the advantages of newer printing technologies.

2. **Claim 3 is rejected under 35 USC 103(a) as being unpatentable over Freedman, patent number 4,839,829, and Seybold Report (a collection of articles cited in PTO-892 Items: U and V), as applied to Claim 1, in further view of Official Notice.**

Freedman and Seybold Report teach all the above as noted under the 103(a) rejection and further teach requesters changing configurations prior to receiving cost information, and requesters dealing with multiple aspects of a print job specification that determine cost, but do not specifically disclose making repetitive calculations. This examiner takes the position that Freedman and Seybold Report disclose substantial attention to helping requesters determine their printing cost in advance to committing an order to a service provider. It is inconceivable to this examiner that Freedman and Seybold Report provide "one-shot" calculating schemes that allow the requester only one try at estimating cost prior to committing to an order and thereby preventing repetitive calculations. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to include repetitive cost estimating as taught by Official Notice, in order to better help requesters determine printing costs.

- 3. Claims 7 and 8 are rejected under 35 USC 103(a) as being unpatentable over Freedman, patent number 4,839,829, and Seybold Report (a collection of articles cited in PTO-892 Items: U and V), as applied to Claim 1, in further view of Official Notice.**

Freedman and Seybold Report teach all the above as noted under the 103(a) rejection and further teach electronic job submission comprising copy and proofs and accessing proofs electronically via URLs (see at least Item U, page 2), but does not disclose obtaining approval from requesters of said proofs. This

Art Unit: 3625

examiner takes the position that the purpose of using proofs is to gain approval from the requester prior to purchasing the finished product, else most if not all the need for the proof is a wasted exercise. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to obtain requester's approval of the electronically accessible proofs as taught by Official Notice, in order to ascertain the requester's agreement with the proposed finished product.

4. **Claim 14 is rejected under 35 USC 103(a) as being unpatentable over Freedman, patent number 4,839,829, and Seybold Report (a collection of articles cited in PTO-892 Items: U and V), as applied to Claim 12, in further view of Printing Impressions (PTO-892 Item: W).**

Freedman and Seybold Report teach all the above as noted under the 103(a) rejection but do not disclose RGB format. Printing Impressions teaches desktop publishing Pantone's ColorDrive with web tools application-independent desktop color management system. Printing Impressions teaches color spaces comprising CMYK, RGB, HSL, Apple Color Picker, CIE, and YIQ, and standard printing and publishing applications (please see Item: W, page 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Freedman and Seybold Report to include RGB format as taught by Printing Impressions, in order to produce more complex colors.



***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 6,330,542 (Sevcik et al.) 11 December 2001; teach an automated Internet quoting and procurement system and process for commercial printing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

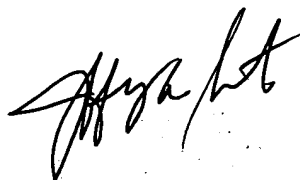
or faxed to:

**703-305-7687** (Official communications; including After Final communications labeled "Box AF")

Art Unit: 3625

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RMP  
December 9, 2002

A handwritten signature in black ink, appearing to read "Haya / St".